

### REMARKS

The application was originally filed with claims 1-20. In response to an election requirement claims 1-14 were elected for prosecution without traverse. In response to the first Office Action new claims 21-26 were added. In response to the current Office Action, claims 1 and 7 have been amended. Accordingly, claims 1-14 and 21-26 are pending and at issue.

#### Response to the §102 Rejections

Claims 1, 4, 7-11, 21, and 24 were rejected under §102 as anticipated by U.S. Patent 4,964,432 ("Chou"). Applicant respectfully submits that *Chou* fails to disclose each and every element of the amended claims and, therefore, fails to anticipate independent claims 1, 7 and 21.<sup>1</sup>

Claim 1 as amended recites "a substantially cylindrical housing adapted to be removably secured to a portion of the valve stem disposed between the valve plug and the packing box...wherein at least a portion of the housing is disposed between an end of the valve plug and the packing box." Similarly, claim 7 as amended recites "a valve plug...; a packing box; and...a sleeve...wherein at least a portion of the sleeve is disposed between an end of the valve plug and the packing box." *Chou* fails to disclose such elements.

Instead, *Chou* discloses a valve having a housing (32) that is screwed into a body (12). The housing (32) includes packing rings (32), an area for receiving the packing rings (32), and a stem 46 having a valve member (62) at an end thereof. A split connector (76) fits about a frustoconical section (56) of the stem (46), and a retainer sleeve (84) fits about the connector (76) to hold the two halves of the connector (76) on the stem. The split connector (76) and retainer sleeve (84), cited in the Office Action as responsive to the sleeve and cylindrical housing of the claims, are both entirely positioned inside the plug member (62), with no portion of the either the connector (76) or the retainer sleeve (84) being disposed between an end of the plug member (62) and the packing box.

Consequently, in contrast to the present application, *Chou* does not disclose or even teach a housing or sleeve having a portion that is disposed between an end of the valve plug and the packing box.

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<sup>1</sup> "Anticipation under 35 U.S.C. § 102 requires the disclosure in a single piece of prior art of each and every limitation of a claimed invention." *Rockwell International Corp. v. United States*, 47 USPQ2d 1027 (Fed. Cir. 1998).

Similarly, claim 21 recites “a substantially cylindrical housing having...a first end for engaging a portion of the valve plug, [and] a second end for engaging a portion of the seal assembly.” *Chou* fails to disclose such elements, nor were these limitations even addressed in the currently pending Office Action.

Regardless, as described in detail above, the *Chou* connector (76) or retainer sleeve (84) is disposed entirely inside the plug member (62), without any portion of the connector (76) or the retainer sleeve (84) protruding outside the plug member (62). As a result, there is no way the connector (76) or the retainer sleeve (84) has a first end for engaging a portion of the valve plug and a second end for engaging a portion of the seal assembly.

Accordingly, the anticipation rejections of claims 1, 7, 21 and their dependent claims based on *Chou* must be withdrawn.

#### Response to 35 U.S.C. §103 Rejection

Claims 2 and 22, and alternatively 1 and 21, were rejected under 35 U.S.C. §103 as obvious over *Chou* in view of United States Patent 3,262,673 (“*Seeley*”), claims 3 and 23 were rejected as obvious over *Chou* in view of *Seeley* further in view of United States Patent 4,270,730 (“*Hinrichs*”), and claims 5-6, 12-14, 25 and 26 and alternatively claims 4 and 11 were rejected as obvious over *Chou* in view of United States Patent 5,788,216 (“*Pittman*”).

The above rejected claims cannot be considered obvious as any combination of these references fails to teach or suggest all of the claimed limitations and, as such, a *prima facie* case of obviousness has not been established.<sup>2</sup> More specifically, none of the references alone or in combination teach or suggest a housing or sleeve having a portion that is disposed between an end of the valve plug and the packing box, as is recited in the claims.

First, the deficiencies of *Chou* are noted above.

Second, *Seeley*, as seen in Fig. 1, teaches two split sleeve sections (19, 20) that are disposed within a stopper (11). The split sleeve sections (19, 20) connect the stopper (11) to the stopper rod (15). As a result, *Seeley* and *Chou* teach and suggest the same structure—a connector or sleeve entirely disposed inside a plug or stopper—and fail to teach or suggest a

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<sup>2</sup> “To establish a *prima facie* case of obviousness, ... there must be some suggestion or motivation ... to modify the references or to combine reference teachings ... [, and] the prior art reference (or references when combined) must teach or suggest ‘all’ the claimed limitations. (Internal quotations added). See MPEP § 2142.

housing or sleeve having a portion that is disposed between an end of the valve plug and the packing box.

Third, *Hinrichs* and *Pittman* do not even teach a simple relationship between a plunger and a sleeve or housing. As a result, neither *Hinrichs* nor *Pittman*, with or without the combination of *Seeley* and *Chou*, is capable of teaching or suggesting a housing or sleeve having a portion that is disposed between an end of the valve plug and the packing box, as is recited in the claims.

Finally, none of the above-cited references provide a suggestion or motivation to modify the references or to combine teachings of the references to arrive at the rejected claims.<sup>3</sup> Specifically, motivation may be obtained from the nature of the problem to be solved, the teachings of the prior art, or the knowledge of persons of ordinary skill in the art.<sup>4</sup> None of these scenarios are present here. In particular, none of the cited references are attempting to solve the same problem described in the present application, and none of the cited references provide such a teaching or motivation. As a result, the only possible suggestion or motivation must be the knowledge of persons of ordinary skill in the art, which must be more than the level of skill in the art,<sup>5</sup> and rarely supplies the missing knowledge or prior art to reach obviousness.<sup>6</sup> In order for the examiner to provide such motivation, he must provide evidence that he is a person of ordinary skill in the art, and evidence of the knowledge being used. This has not been done.

Accordingly, each of the obviousness rejections must be withdrawn.

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<sup>3</sup> “[T]here must be some suggestion or motivation...to modify or combine the references.” See MPEP § 2145 X. C.

<sup>4</sup> See MPEP § 2143.01.

<sup>5</sup> “The level of skill in the art cannot be relied upon to provide the suggestion to combine references.” *Al-Site Corp. v. VSI Int’l Inc.*, 174 F.3d 1308 (Fed. Cir. 1999).

<sup>6</sup> *Id.* at 1324.

### CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the examiner is respectfully requested to pass this application to issue. Additionally, if in the opinion of the examiner a telephone conference would expedite prosecution of the subject application, the examiner is invited to call the undersigned.

Dated: August 4, 2005

Respectfully submitted,

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